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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,577	06/28/2001	Shigefumi Sakai	210354US0	2545

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EXAMINER
YU, GINA C

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 03/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/892,577	Applicant(s) SAKAI ET AL.	
	Examiner Gina C. Yu	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) 4-16 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-3 and 17-19 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 4 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3 and 17-19, drawn to cosmetic composition, classified in class 424, subclass 401.

II. Claims 4-13, drawn to a hydrogel particle, classified in class 424, subclass 492.

III. Claims 14-16, drawn to process of making a hydrogel particle, classified in class 264, subclass 4.1.

Inventions II and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as hydrogel particles that have various applications besides cosmetics, such as food or oral medication. The inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, hydrogel particles in general can be made by various processes materially distinct from invention in Group III.

Similarly, inventions III and I are related as process of making an intermediate product and a final product. The product made by the process in Group III can be useful in applications other than cosmetics.

These inventions are distinct for the reasons given above. The search required for Group I is not required for Group II or III, and the search required for Group II is not required for Group III. These inventions have recognized divergent subject matter, and have acquired a separate status in the art as shown by their different classification. Thus restriction for examination purposes as indicated is proper.

During a telephone conversation with Kirsten Gruneberg on January 7th, 2002, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-3 and 17-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

1. Claims 1-3 are rejected under 35 U.S.C. 102 (a), (b) and (e) as being anticipated by Noda et al. (US 5089269) ("Noda", hereunder).

Noda discloses skin cosmetics such as lotions which contain oily components and emulsifiers enclosed in gelatin microcapsules in the aqueous phase. See Examples 3-1 through 3-7. The gelatin capsules in Noda are considered to be "non-crosslinked hydrogel" as applicants define in instant specification p. 5, lines 21 – p. 6, line1, since the gel in Noda is formed by dissolving the gelatin in heated water and cooling. See Noda, Example 3-1. See also col. 8, lines 45 – 51 for suitable water-soluble polymers including agar.

2. Claims 1-3 are rejected under 35 U.S.C. 102(a) and (b) as being anticipated by Dobuwoj et al., EP 900558 A2, English translation.

Dubuwoj discloses aqueous hair compositions comprising microparticles containing oily conditioning substances and emulsifiers, which are homogeneously distributed in the base. See translation p. 1, line 1 – p. 2, line 3; Examples. The microparticles contain agar-agar, and are non-crosslinked. The term "skin care

composition" recited in the instant claim is an intended use which is not considered as a claim limitation. See MPEP § 2111.02.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noda as applied to claims 1-3, and further in view of Hegyi et al. (US 6251409 B1) ("Hegyi").

Noda, discussed above, further teaches that the viscosity of the compositions ranges from 1000 to 20000 cps, which is within the claimed range in the instant claim 17. See col. 5, lines 56 – 63. While the reference lacks the teaching of the specific gravity

of the composition, it discloses a prior art which is a solution containing capsules with improved dispersity by adjustment of the specific gravity. See col. 3, lines 40 – 45. Based on this disclosure in Noda, examiner views that a routineer would have discovered the optimal range of the specific gravity of the aqueous medium of the instant invention by routine experimentation. Examiner also notes that there is no evidence indicating such range of density is critical.

Noda fails to teach that the gelatin particles in the cosmetic compositions are visibly recognizable. See instant claim 17. While the reference teaches that the gelatin capsules are transparent in col. 10, lines 4 - 8, colored microcapsules are disclosed for the purpose of showing that microcapsules containing separate oil components can be produced at once. See col. 6, lines 34 – 44; Examples 8-1 through 8-3. While these colored particles are considered to be "visibly recognizable" under applicants' definition in specification p. 23, lines 8 – 18, the reference is silent as to actual application of these colored microcapsules in the cosmetic products.

Hegyi teaches visually distinct cosmetic compositions such as lotions and creams, which contains transparent and colored agarose particles dispersed throughout the base. See abstract; col. 1, line 14 – col. 19. The size of the colored particles is in the range of 0.3 – 1.5 mm. See col. 2, lines 20 – 39.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the disclosed composition in Noda by substituting the colored microcapsules for transparent, non-colored microcapsules, as motivated by

Hegyi, because of the expectation of successfully producing visually distinctive and aesthetic cosmetic composition.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goto et al. (EP 0389700), p. 5, lines 46 – 59; Example 10 (teaching aqueous cream mixed with soft agar capsules containing oil).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
March 13, 2002

MINNA MOEZIE, J.D.
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